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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,909	09/30/2003	Timothy Brian Nestor	030627/267422	9010
826	7590	12/17/2008		
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER NGUYEN, PHU HOANG	
			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			12/17/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/674,909

**Applicant(s)**

NESTOR ET AL.

**Examiner**

PHU H. NGUYEN

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10,12-26 and 28-57 is/are pending in the application.
- 4a) Of the above claim(s) 53-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-26 and 28-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/8/2008 has been entered.

### ***Election/Restrictions***

Newly submitted claims 53-57 are directed to an invention that is unrelated to the invention originally claimed for the following reasons: Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, the smokable rod of the invention originally claimed cannot be made by the process for preparing a reconstituted tobacco material.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 53-57 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7-10, 15-16, 38-39 and 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Jakob et al. (U.S. Patent No. 5129408).

Regarding claims 1, 3-5, 7-10, 15-16 and 38-39, Jakob et al discloses a cigarette and smokable material therefor which comprises, as seen in the Figures, a lighting end and a mouth end. An outer paper wrapping material 25 circumscribes a rod (corresponding to the claimed "inner portion") which includes a smokable material 25 which is comprised of some form of tobacco (i.e. expanded, reconstituted, laminae, stems, etc) in intimate contact with aerosol forming/casing materials, such as glycerin. Jacob further discloses the tobacco-containing smokable filler material can be cast as a sheet from an aqueous slurry, provided as a sheet using a paper making process (corresponding to the claimed smokable material comprises a processed tobacco material comprising an aqueous extracted tobacco pulp having at least a portion of the aqueous soluble portion removed therefrom such that the aqueous extracted tobacco pulp is a substrate); such a tobacco containing smokable filler material can be employed individually as the sole smokable material of the cigarette, or that tobacco containing smokable filler material can be physically mixed (column 3, lines 1-14). As clearly evident from the drawings, the rod has a cylindrical shape and the lighting end is open

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to expose the rod such that the smokable material of the rod is positioned for lighting at the lighting end (See entire document and figs.).

Regarding claims 15-16, Jakob discloses aerosol forming materials can be applied as a spray (column 12, lines 29-34).

Regarding claims 40-41, Jakob further discloses the sheet has an alginate and a binder (Abstract).

Regarding claim 42, Jakob discloses the aerosol forming material comprises glycerin (column 3, lines 4-5).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 12-14, 17, 19-26, 28-37, 43-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakob et al. (U.S. Patent No. 5129408) in view of Perfetti et al. (U.S. Patent No. 4924888).

Regarding claims 6, 17, 19-26, 31-37, 43-44 and 48-49 Jakob discloses the features as discussed above for claims , 3-5, 7-10, 15-16, 38-39 and 40-42 but Jakob does not expressly disclose that the smokable material comprising greater than about 90 percent tobacco, based on the dry combined weight of the tobacco and any non-tobacco filler material. Perfetti discloses a smokable rod (10, fig. 1) comprising a lighting end and a mouth end (see fig. 1), an inner portion incorporating a smokable

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material (from about 80 to about 90 percent by weight of flue-cured tobacco material and 10 to about 20 percent by weight of Oriental tobacco material) (corresponding to the claimed "greater than about 90 percent tobacco, based on the dry combined weight of the tobacco and any non-tobacco filler material") (column 5, line 36-39), and glycerin (an aerosol forming/casing material) in intimate contact with a process tobacco material (can be a blend of flue cure tobacco material with processed tobacco stems, reconstituted tobacco material and Oriental tobaccos if desired as shown on column 5, line 7-13) (example 4, column 10, line 55-61). At the time of invention it would have been obvious to one having ordinary skill in the art to use smokable material (more than 90 percent tobacco by weight of tobacco and non-tobacco filler material) taught by Perfetti in the cigarette of Jakob for the taste of flue-cured tobacco and Oriental tobacco.

Furthermore, Perfetti discloses the cigarette paper wrap is available commercially; in example 5, the paper has an inherent permeability of 15 CORESTA (column 11, line 23-31). The wrapping materials can be processed in order to have a relatively high net permeability values such as about 50 to about 250 CORESTA units (column 7, line 20-30). Therefore, one of ordinary skill in the art at the time the invention was made can obtain the commercially available cigarette paper wrap and process it to a desired permeability value.

Regarding claims 12-14 and 28-30, Jakob discloses the smokable material includes up to about 20, preferably about 3 to about 15 percent aerosol forming material overlapping with the claimed ranges in the instant claims 11-14 (column 6, lines 6-11).

Regarding claims 45-46 and 50-51, Jakob further discloses the sheet has an alginate and a binder (Abstract).

Regarding claims 47 and 52, Jakob discloses the aerosol forming material comprises glycerin (column 3, lines 4-5).

### ***Response to Arguments***

Applicant's arguments filed 1/09/2008 have been fully considered but they are not persuasive.

Applicant essentially argues that the amended claim 1 further clarify the intimate contact between the aqueous extracted tobacco pulp and the aerosol forming material and there is certainly no reference to the incorporation of an aerosol forming material during any processing of the tobacco material. However, Jakob (5129408) discloses a smokable filler material also can include certain flavoring agents and/or aerosol forming materials in intimate contact therewith and smokable filler material can be cast as a sheet from an aqueous slurry, provided as a sheet using a paper-making process (column 3, lines 29-34). Therefore, Jakob discloses the incorporation of an aerosol forming material in the aqueous extracted tobacco pulp.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHU H. NGUYEN whose telephone number is (571)272-5931. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.N 12/10/2008

***/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791***